

REMARKS

Claims 1 through 20 are pending in the application.

In the Office action mailed on 13 June 2006 (Paper No. 20060610), the Examiner required a restriction under 35 U.S.C. §121 and 37 CFR §1.142, between:

- **Species I** covered by claims 12-14, directed to first embodiment (paragraphs [0043]-[0052]), Fig. 3A to 3E;
- **Species II** covered by claims 15-17, directed to second embodiment (paragraphs [0053]-[0057]), Fig. 4A to 4D;
- **Species III** covered by claims 18-20, directed to third embodiment (paragraphs [0058] to [0063]), Fig. 5A to 5D.

Applicants respectfully traverse the election requirement imposed in the Office action, but provisionally elect Species II covered by claims 15-17, directed to second embodiment (paragraphs [0053]-[0057]), Fig. 4A to 4D. The requirement for an election of species is improper and its withdrawal and examination of all pending claims is respectfully urged.

First, in support of this second and belated requirement for an election of species under 37 CFR §1.146, Paper No. 20060610 states that,

“Even though the inventions are classified together (class 445/subclass 24) each invention can be shown to have formed a separate subject for inventive effort and there would be a serious burden on the Examiner and hence restrict requirement is proper.”¹

The record is devoid of evidence which would support a finding of “serious burden” as alleged. As of the 13th of July 2006, class 445, subclass 24 contains one thousand, three hundred and sixty

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Examiner’s Comments, Paper No. 20060610, page 3.

(1,360) issued patents. As noted by the Examiner's Comments, not all of these issued patents are material to the patentability of Applicant's pending claims; all are however, within the field of mandatory search. Moreover, almost all of these references provide detailed descriptions of devices and processes for manufacture. Several very recent exemplars not only have issued claims for both methods of manufacture and devices, but multiple species of methods of manufacture. In point of fact, 37 CFR §1.146 expressly contemplates that absent a generic claim, examination of a "reasonable number of species." Paper No. 20060610 makes no averment of a generic claim. Applicant submits that three related species is a "reasonable number", and urges withdrawal of the requirement.

Second, a review of recent issues within class 445, subclass 24 demonstrates that well over fifty percent of those issued patents contain method claims directed to multiple species. The sheer number and diversity of recently issued patent demonstrates that the examination of those applications neither imposed a "serious burden" upon the Examining staff nor required "divergent searches" as is suggested by Paper No. 20060610.² The imposition of a requirement in this application unfairly deprives Applicant of the rights accorded by the Office to those patentees.

Third, the requirement imposed by Paper No. 20060610 is untimely and improper under the express dictates of 37 CFR §1.146, which restricts the imposition of an election of species to two scenarios: (i) a *first* action in an application containing a generic claim and (ii) the presence of "more than a reasonable number of species"; there is no evidence in Paper No. 20060610 that either condition precedent has been satisfied. Accordingly, the imposition is improper; its withdrawal and

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Paper No. 20060610 fails to state either how a search of similar structures and the processes of manufacturing those structures could possibly create either "a serious burden" or require "divergent searches." Indeed, no explanation of "divergent searches" is given by either Paper No. 20060610 or 37 CFR §1.146.

examination of all pending claims is respectfully requested.

In view of the foregoing demonstration of the impropriety of this requirement, it is requested that the restriction requirement be withdrawn. It is further submitted that the application is in condition for examination on the merits, and early allowance is requested.

No fee is incurred by this response.

Respectfully submitted,



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